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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/033,225	10/25/2001	Jeffrey G. Wiley	10016469-1	8739

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
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EXAMINER

EHICHIOYA, FRED I

ART UNIT	PAPER NUMBER
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2162

DATE MAILED: 07/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/033,225

Applicant(s)

WILEY, JEFFREY G.

Examiner

Fred I. Ehichioya

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4 - 12, 14 - 27 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1, 4 - 12, 14 - 27 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☒ Other: See Continuation Sheet.

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Continuation of Attachment(s) 6). Other: Notice of Non-Compliant Amendment (37 CFR 1.121).

DETAILED ACTION

1. Claims 1, 4 – 12 and 14 – 27 are pending in this Office Action.
2. Applicant's request for the withdrawal of Claims Rejections under 35 U.S.C 112 is persuasive, Therefore, Claims Rejections under 35 U.S.C 112 is hereby withdrawn.

However, Applicant fails to remedy the issues of Claims Rejections under 35 U.S.C 101 raised during the interview with Mark D. Trenner on April 11, 2005.

Therefore, claims 1 and 12 are still non-statutory.

Response to Arguments/Remarks

3. Applicant argues:

(a) "There is not teaching of a user-specified remote storage device. Nor is there any teaching of accessing an electronic document at a user-specified remote storage device and sending the electronic document from multifunction device (page 9, paragraph 1).

(b) The cited references fail to teach or suggest at least "combining said documents in electronic format with said electronic document from said user-specified remote storage device". (Page 12, paragraph 5).

(c) Citations do not teach or suggest at least "identifying a remote storage device having a use-requested document based at least in part on a path for said remote storage device specified by a user at said configured multifunction device" (page 14, paragraph 2).

In response to argument (a): Examiner respectfully disagrees with the applicant.

Czyszczewski teaches a user-specified remote storage device as shown in column 3, lines 11 –20).

accessing an electronic document at a user-specified remote storage device (see column 3, lines 14 – 17) and

sending the electronic document from multifunction device (see column 7, lines 19 – 23).

In response to argument (b): Examiner respectfully states that Czyszczewski teaches combining said documents in electronic format with said electronic document from said user-specified remote storage device as shown in column 6, lines 53 – 59 and column 10, lines 59 – 60).

In response to argument (c): Examiner respectfully states that Czyszczewski teaches identifying a remote storage device having a use-requested document based at least in part on a path for said remote storage device specified by a user at said configured multifunction device as shown in column 3, lines 11 – 17 and column 9, line 60 – column 10, line 3).

4. In view of the above, the examiner contends that all limitations as recited in the claims have been addressed in this Office Action. For the above reasons, Examiner believed that the rejection of the last Office Action was proper.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 and 12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

MPEP 2106 IV.B.2.(b)

A claim that requires one or more acts to be performed defines a process. However, not all processes are statutory under 35 U.S.C. 101. *Schrader*, 22 F.3d at 296, 30 USPQ2d at 1460. To be statutory, a claimed computer-related process must either: (A) result in a physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan, or (B) be limited to a practical application within the technological arts.

MPEP 2106.II.A

A process that consists solely of the manipulation of an abstract idea is not concrete or tangible. See In re Warmerdam, 33 F.3d 1354, 1360, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994).

Claims 1 and 12 in view of the above cited MPEP sections, are not statutory because they merely recite a number of computing steps without producing any tangible result and/or being limited to a practical application within the technological arts. **The use of a computer has not been indicated.**

These claims do not indicate use of hardware on which the software runs to perform the steps recited in the body of the claim. Software or program can be stored on a medium and/or executed by a computer. In other words the software must be computer-readable. **The use of a computer is not evident in the claim.**

MPEP 2106.IV.B.1(a) refers to "computer-readable" medium with computer program encoded on it."

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 1, 4 – 12, and 14 - 27 rejected under 35 U.S.C. 102(e) as being anticipated by U.S Patent 6,577,907 issued to Joseph Stanley Czyszczewski et al. (hereinafter "Czyszczewski").

Regarding claim 1, Czyszczewski teaches a method for providing access from a multifunction device to an electronic document at a user-specified remote storage device (see column 6, lines 53 – 57 and column 7, lines 12 – 16: Czyszczewski discloses accessing multifunction device and documents in electronic format; see also Abstract), comprising:

identifying said user-specified remote storage device having said electronic document based at least in part on a path thereto specified by a user at said

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multifunction device (see column 3, lines 11 – 17: Czyszczewski discloses remote storage or databases that implements the current invention).

establishing a link between said multifunction device and a user-specified remote storage device having said electronic document (see Fig. 3 and column 3, lines 15 – 20: the connection between the multifunction device and the remote data-store or databases is through common networking interfaces such as Internet or LAN); and

accessing said electronic document at said user-specified remote storage device from said multifunction device over said link established therebetween (see column 3, lines 50 – 51 and column 6, lines 55 – 56: Czyszczewski disclose accessing remote datastores and the datastores contain among other,, the electronic document); and

sending said electronic document from said multifunction device (see column 7, lines 19 – 23: the user operates the multifunction device to send the document to the selected destination).

Regarding claim 4, Czyszczewski teaches identifying said user-specified remote storage device is based at least in part on a user profile (see column 3, lines 50 – 55).

Regarding claim 5, Czyszczewski teaches converting a document to electronic format at said multifunction device (see column 6, lines 53 - 59); and

combining said document in electronic format with said electronic document from said user-specified remote storage device (see column 10, lines 59 – 60).

Regarding claim 6, Czyszczewski teaches combining said electronic document from said user-specified remote storage device with an electronic document generated at said multifunction device (see column 10, lines 48 - 609); and

sending said combined electronic documents from said multifunction device to a network destination (see column 7, lines 62 – 65 and column 12, lines 25 – 27).

Regarding claim 7, Czyszczewski teaches accessing an address book operatively associated with said user-specified remote storage device (see column 12, lines 8 – 14).

Regarding claim 8, Czyszczewski teaches identifying a network destination for an electronic document generated at said multifunction device based on data from said address book (see column 14, lines 14 – 20).

Regarding claim 9, Czyszczewski teaches editing an entry in said address book operatively associated with said user-specified remote storage device from said multifunction device (see column 10, lines 59 - 60).

Regarding claim 10, Czyszczewski teaches configuring said multifunction device before identifying said user-specified remote storage device (see column 3, lines 56 – 60).

Regarding claims 11 and 20, Czyszczewski teaches displaying at least a portion of electronic document from said user-specified remote storage device at said multifunction device (see column 10, lines 21 - 24).

Regarding claim 12, Czyszczewski teaches a method for accessing user-requested data from a configured multifunction device (column 7, lines 12 – 16: Czyszczewski discloses accessing multifunction device and documents in electronic format; see also Abstract), comprising:

identifying a remote storage device having a user-requested document based at least in part on a path for said remote storage device specified by a user at said configured multifunction device (see column 3, lines 11 – 17: Czyszczewski discloses remote storage or databases that implements the current invention).

retrieving said user-requested document from said configured multifunction device (see column 10, lines 21 – 27: (see column 3, lines 11 – 17: Czyszczewski discloses retrieving documents from remote storage using multifunction device).

Regarding claim 14, Czyszczewski teaches identifying said remote storage device is based at least in part on a user profile (see column 3, lines 50 – 55).

Regarding claim 15, Czyszczewski teaches converting a document to electronic format at said configured multifunction device (see column 6, lines 53 - 59); and

combining said document in electronic format with said retrieved user-requested document (see column 10, lines 50 - 60).

Regarding claim 16, Czyszczewski teaches combining said retrieved user-requested document with an electronic document generated at said configured multifunction device (see column 10, lines 48 - 60); and

sending said combined electronic document and retrieved user-requested document from said configured multifunction device to a network destination (see column 7, lines 62 – 65 and column 12, lines 25 - 27).

Regarding claim 17, Czyszczewski teaches retrieving user-requested data from an address book operatively associated with said remote storage device (see column 12, lines 8 – 14).

Regarding claim 18, Czyszczewski teaches identifying a network destination for an electronic document generated at said configured multifunction device based on said user-requested data retrieved from said address book (see column 14, lines 14 – 20).

Regarding claim 19, Czyszczewski teaches editing an entry in said address book operatively associated with said remote storage device from said multifunction device (see column 10, lines 59 - 60).

Regarding claim 21, Czyszczewski teaches a multifunction device comprising:
computer-readable media operatively associated with said multifunction device
and having computer-readable program code thereon including program code for
identifying data operatively associated with a user-specified remote storage device (see
column 9, line 60 – column 10, line 3); and
program code for accessing said data operatively associated with said user-
specified remote storage device from said multifunction device (see column 10, lines 21
- 26).

Regarding claim 22, Czyszczewski teaches said data is an address book (see
column 12, lines 8 – 14).

Regarding claim 23, Czyszczewski teaches program code for retrieving an entry
from said address book, said entry identifying a network destination (see column 12,
lines 8 – 23);

program code for associating said entry from said address book with an
electronic document at said multifunction device (see column 7, lines 14 – 26); and

program code for sending said electronic document to said network destination
identified by said entry from said address book (see column 7, lines 16 – 22).

Regarding claim 24, Czyszczewski teaches said data is a document in electronic
format (see column 2, lines 65 – 67).

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Regarding claim 25, Czyszczewski teaches program code for sending a document in electronic format from said multifunction device to a network destination (see column 3, lines 1 – 7 and column 7, lines 12 – 25).

Regarding claim 26, Czyszczewski teaches program code for combining a document in electronic format with a document image at said multifunction device (see column 9, lines 3 – 7);

program code for sending said combination of said document in electronic format and said document image from said multifunction device to a network destination (see column 5, lines 30 – 40).

Regarding claim 27, Czyszczewski teaches said user-specified remote device is another multifunction device (see column 7, lines 26 – 40).

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fred I. Ehichioya whose telephone number is 571-272-4034. The examiner can normally be reached on M - F 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on 571-272-4107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Fred I. Ehichioya
Patent Examiner
Art Unit 2162

July 7, 2005


SHAHID ALAM
PRIMARY EXAMINER

**Notice of Non-Compliant
Amendment (37 CFR 1.121)**

Application No.

10/033,225

Examiner

Fred I. Ehichioya

Applicant(s)

WILEY, JEFFREY G.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

The amendment document filed on *02 April 2005* is considered non-compliant because it has failed to meet the requirements of 37 CFR 1.121. In order for the amendment document to be compliant, correction of the following item(s) is required.

THE FOLLOWING MARKED (X) ITEM(S) CAUSE THE AMENDMENT DOCUMENT TO BE NON-COMPLIANT:

- ☐ 1. Amendments to the specification:
 - ☐ A. Amended paragraph(s) do not include markings.
 - ☐ B. New paragraph(s) should not be underlined.
 - ☐ C. Other _____.
- ☐ 2. Abstract:
 - ☐ A. Not presented on a separate sheet. 37 CFR 1.72.
 - ☐ B. Other _____.
- ☐ 3. Amendments to the drawings:
 - ☐ A. The drawings are not properly identified in the top margin as "Replacement Sheet," "New Sheet," or "Annotated Sheet" as required by 37 CFR 1.121(d).
 - ☐ B. The practice of submitting proposed drawing correction has been eliminated. Replacement drawings showing amended figures, without markings, in compliance with 37 CFR 1.84 are required.
 - ☐ C. Other _____.
- ☒ 4. Amendments to the claims:
 - ☒ A. A complete listing of all of the claims is not present.
 - ☐ B. The listing of claims does not include the text of all pending claims (including withdrawn claims)
 - ☒ C. Each claim has not been provided with the proper status identifier, and as such, the individual status of each claim cannot be identified. Note: the status of every claim must be indicated after its claim number by using one of the following status identifiers: (Original), (Currently amended), (Canceled), (Previously presented), (New), (Not entered), (Withdrawn) and (Withdrawn-currently amended).
 - ☐ D. The claims of this amendment paper have not been presented in ascending numerical order.
 - ☐ E. Other: _____.

For further explanation of the amendment format required by 37 CFR 1.121, see MPEP § 714 and the USPTO website at <http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/officeflyer.pdf>.

TIME PERIODS FOR FILING A REPLY TO THIS NOTICE:

1. Applicant is given **no new time period** if the non-compliant amendment is an after-final amendment or an amendment filed after allowance. If applicant wishes to resubmit the non-compliant after-final amendment with corrections, the **entire corrected amendment** must be resubmitted within the time period set forth in the final Office action.
2. Applicant is given **one month**, or thirty (30) days, whichever is longer, from the mail date of this notice to supply the **corrected section** of the non-compliant amendment in compliance with 37 CFR 1.121, if the non-compliant amendment is one of the following: a preliminary amendment, a non-final amendment (including a submission for a request for continued examination (RCE) under 37 CFR 1.114), a supplemental amendment filed within a suspension period under 37 CFR 1.103(a) or (c), and an amendment filed in response to a *Quayle* action.

Extensions of time are available under 37 CFR 1.136(a) only if the non-compliant amendment is a non-final amendment or an amendment filed in response to a *Quayle* action.

Failure to timely respond to this notice will result in:

Abandonment of the application if the non-compliant amendment is a non-final amendment or an amendment filed in response to a *Quayle* action; or

Non-entry of the amendment if the non-compliant amendment is a preliminary amendment or supplemental amendment.